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JUN 29 2007

OFFICE OF PETITIONS

In re Application of	:	
EVERETT et al	:	
Application No.: 09/932,013	:	DECISION ON PETITIONS
Filing Date: August 17, 2001	:	UNDER 37 CFR 1.55 and 1.78
Attorney Docket No.: 017268-0352595	:	

This is a decision on the renewed petition under 37 CFR 1.55(c), filed March 2, 2007, for acceptance of an unintentionally delayed claim under 35 U.S.C. 119(a)-(d) for benefit of the filing date of foreign Application No. GB 9703591.9, filed February 21, 1997. The present submission is also being treated as a petition under 37 CFR 1.78 to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to prior-filed nonprovisional application number 09/023,057, filed February 12, 1998. No additional petition fee is due.

The petitions are **DISMISSED**.

I. Petition Under 37 CFR 1.55

The present application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and

the filing date and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6);

(3) the surcharge as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Director may require additional information where there is a question whether the delay was unintentional); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

With regard to item (2) above, the petition states that because a declaration identifying the prior foreign application was submitted in prior-filed U.S. application number 09/023,057, the instant application has always been in compliance with the requirements of 37 CFR 1.63. While the instant application was in compliance with 37 CFR 1.63(d)(iv) in that a newly executed declaration was not required under 37 CFR 1.51(b)(2) and 1.53(f) for the present application to be a complete application, the instant application was not in compliance with 37 CFR 1.63(c)(2) with regard to the foreign priority claim. 37 CFR 1.63(c)(2) specifies that the declaration must identify any foreign application for which priority is claimed, unless such information is supplied on an application data sheet. See also MPEP 201.13, Rev. 5, August 2006, Section II. A., The Priority Claim. The copy of the declaration filed on August 17, 2001 does not contain the required foreign application information, nor does the fact that a declaration containing the foreign priority claim was filed in the "grandparent application" satisfy the requirement under 37 CFR 1.63(c)(2), *ab initio*, as 37 CFR 1.63(d)(iv) requires, *inter alia*, that a copy of such declaration must be submitted in the child application. The copy of the declaration submitted in U.S. application number 09/023,057 accompanying the renewed petition is not acceptable as the provisions of 37 CFR 1.63(d) are limited to continuation and divisional applications, and the instant application does not contain a proper benefit claim under 35 U.S.C. 120 and 37 CFR 1.78(a)(2) to U.S. application number 09/023,057 for the reasons set forth in §II below.

Furthermore, with regard to item (5) above, as set forth in §II below, applicant has not established a proper priority claim under 37 CFR 1.78 to an application which was filed within 12 months of the filing date of the foreign application.

In view of the above, the requirements of 37 CFR 1.78 must be satisfied as set forth below if applicant desires to claim priority to the foreign application noted in the petition.

II. Petition Under 37 CFR 1.78

A petition for acceptance of a late claim for priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate

only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in 37 CFR 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The specification as filed does not properly indicate the relationship between U.S. application number 09/023,057 and U.S. application number 09/076,551. 37 CFR 1.78(a)(2)(i) provides that a nonprovisional application claiming the benefit of one or more prior-filed nonprovisional applications must indicate the relationship of the applications. MPEP 201.11, Rev. 5, August 2006, Section III. A., Reference to Prior Nonprovisional Applications, further specifies that "if the benefit of more than one nonprovisional application is claimed, then the relationship between each application (i.e., continuation, divisional, or continuation-in-part) must be specified in order to establish copendency throughout the entire chain of prior-filed applications."

The renewed petition attempts to correct this defect. However, the petition does not satisfy item (1) above. Although the petition states that the priority claim language is "being amended" and requests the USPTO to "enter the requested language in the first paragraph of the specification", an amendment after payment of the issue fee is not permitted under 37 CFR 1.312. Furthermore, the purported amendment is not in compliance with 37 CFR 1.121 as the amendment to the specification does not begin on a separate sheet. 37 CFR 1.121(h). Moreover, the proposed language does not include a proper benefit claim to U.S. provisional application numbers 60/046,514 and 60/046,543 because the instant application was not filed within 12 months after the date on which the provisional applications were filed. See MPEP 201.11, Rev. 5, August 2006, Section III. C., Benefit Claims to Multiple Prior Applications (stating "[I]f the instant nonprovisional application is not filed within the 12 month period, but claims the benefit of an intermediate nonprovisional application under 35 U.S.C. 120 that was filed within 12 months from the filing date of the provisional application and claimed the benefit of the provisional application, the intermediate application must be clearly identified as claiming the benefit of the provisional application. . . .")

The petition also does not satisfy item (3) above in that a proper statement of unintentional delay has not been furnished.

A corrected filing receipt which indicates those applications to which priority is properly claimed accompanies this decision.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
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 Mail Stop Petitions
 Randolph Building
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By fax: (571) 273-8300
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Any questions concerning this matter may be directed to Bryan Lin at (571) 272-3303.



Bryan Lin
Legal Examiner
Office of PCT Legal Administration



Boris Milef
Legal Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	TOT CLMS	IND CLMS
09/932,013	08/17/2001	2137	1090	40000059-0150	4	4

CONFIRMATION NO. 4815

CORRECTED FILING RECEIPT



OC000000024594478

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Date Mailed: 06/28/2007

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

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Power of Attorney: The patent practitioners associated with Customer Number 26263.

Domestic Priority data as claimed by applicant

This application is a CON of 09/076,551 05/12/1998 PAT 6,317,832
 which claims benefit of 60/046,514 05/15/1997
 and claims benefit of 60/046,543 05/15/1997

Foreign Applications

If Required, Foreign Filing License Granted: 09/14/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US09/932,013**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

SECURE MULTIPLE APPLICATION CARD SYSTEM AND PROCESS

Preliminary Class

713

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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